

## REMARKS/ARGUMENTS

### *Status of Claims*

The Examiner has apparently missed the fact that the Applicant filed a Preliminary Amendment for the present patent application on July 30, 2006, which canceled claims 1-4 and 9-17. As a result of that Preliminary Amendment, only claims 5-8 and 18-25 are pending. The Examiner has rejected all pending claims. The Applicant will address only the rejections and objections pertaining to the pending claims.

### *Claim Objections*

The Examiner has objected to claims 5, 18, 20, and 23, asserting that the Applicant supposedly mixes the description of a system and a method in both the preamble and the body of the claims, thereby the Examiner is of the view that the claim language has been supposedly rendered vague and indefinite. The Applicant respectfully traverses these objections and, motivated by the case of *In re Ahlert and Kruger*, 165 USPQ 418, 420-21 (CCPA 1970), the Applicant hereby challenges this view and respectfully requests that the Examiner show support for this view. Secondly, a preamble “may provide context for claim construction” MPEP § 2111.02(II) (citing *Metabolite Labs., Inc. v. Corp. of Am. Holdings*, 370 F.3d 1354, 1358-62, 71 USPQ2d 1081, 1084-87 (Fed. Cir. 2004)). It is quite common for a method claim preamble to define the system or systems (that is, context) that the steps of a method will apply to.

In addition, MPEP § 2106(IV)(B) recognizes that just because a claim has references to multiple forms of statutory subject matter, that fact does not make a claim a “hybrid” claim:

For example, a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel. Note that an apparatus claim with process steps is not classified as a “hybrid” claim; instead, it is simply an apparatus claim including functional limitations. See, e.g., *R.A.C.C. Indus. v. Stun-Tech, Inc.*, 178 F.3d 1309 (Fed. Cir. 1998) (unpublished).

Accordingly, the Applicant respectfully requests that the Examiner withdraw all of the claim objections.

### *Claim Rejections — 35 U.S.C. § 112, Second Paragraph*

The Examiner has rejected claims 6 and 7 under 35 U.S.C. § 112, Second Paragraph, as

supposedly being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, the Examiner asserts, *without support*, that the reference to “second bidders” in both claims 6 and 7 is supposedly inaccurately described. While the Applicant respectfully disagrees with the Examiner’s assertions and maintains that claims 6 and 7 adequately inform one ordinarily skilled in the art, the Applicant has nonetheless amended claims 6 and 7 to specify that “second bidders” cannot include the first bidder, leaving the set of all remaining bidders eligible to be designated a “second bidder”.

Accordingly, the Applicant respectfully requests that the Examiner’s 35 U.S.C. § 112 rejections of claims 6 and 7 be withdrawn.

### ***Claim Rejections — 35 U.S.C. § 102(b)***

The Examiner has rejected claims 5-8 and 18-25 under 35 U.S.C. § 102(b) as supposedly being anticipated by U.S. Patent Application Publication No. 2002/0038282 A1 to Montgomery (Montgomery). The specific claim rejections are respectfully traversed as follows:

#### **Rejections of Claims 5-8 — 35 U.S.C. § 102(b)**

Currently amended independent claim 5 is:

A method for use with a bidding apparatus including a computer, a computer-based auction system, the auction system communicatively coupled with sellers and bidders, the system having records indicative of sellers of items and records indicative of bidders for the items and identifying for each item a winning bidder in an auction, the method comprising the steps, ~~performed by a first bidder~~, of:

by a[[the]] first bidder, selecting a first item;

by the computer, obtaining information indicative of identities of second bidders other than the first bidder who previously placed respective bids for the first item;

by the computer, finding second items other than the first item for which bids have been placed by one or more of the second bidders;

by the first bidder, choosing a second item for which the auction has not yet ended and for which the first bidder has not yet placed a bid; and

by the first bidder, placing a bid for the second item prior to the end of the auction, the bid higher than any bid previously placed for the second item.

The Examiner has cited paragraph [0010] in Montgomery as disclosing the second element of claim 5. However, the undersigned has diligently read the Examiner-cited passage and has failed to identify any wording that even hints at “the computer[] obtaining information indicative of identities of second bidders other than the first bidder who previously placed respective bids for the first item.” The undersigned even went further and performed various electronic word searches of both the Montgomery publication and of the associated and recently issued U.S. Patent No. 7,461,024, and still could not find the second element of claim 5 disclosed. There seems to be absolutely no disclosure in Montgomery related to the identification of competing “second bidders”.

Regarding the third element of claim 5, the undersigned has diligently read the Examiner-cited passage of paragraph [0033] of Montgomery (as well as the associated Figure 2), and has failed to identify any wording that even hints at “the computer[] finding second items other than the first item for which bids have been placed by one or more of the second bidders.” There is perhaps disclosure of a first bidder selecting multiple auctions for the same or several different items; however, that falls far short of reading on the third element of claim 5. The undersigned even went further and performed various electronic word searches of both the Montgomery publication and of the associated and recently issued U.S. Patent No. 7,461,024, and still could not find the third element of claim 5 disclosed.

The fourth element of claim 5 is also not disclosed by Montgomery. The Examiner cites the following passage from the Abstract of Montgomery to supposedly disclose the fourth element of claim 5: “

The method can enable activation of bid proxies as an auction nears completion to begin placing bids until the auction is won or lost by auction closing and can confirm a counter-offer has not out-bid. The method can compute and execute another higher bid if a counter-offer has been made and accepted, higher than the most recent bid detected.

The above passage seems to disclose the updating of a bidder’s bid for an item, but not the selection by a bidder of a second item to bid on, as called for in the fourth element of claim 5.

Because Montgomery does not disclose all of the limitations of independent claim 5, Montgomery cannot anticipate independent claim 5; thus, this claim rejection should be withdrawn. In turn, because dependent claims 6-8 incorporate all of the limitations of independent claim 5, it follows that Montgomery cannot anticipate dependent claims 5-8 either.

Accordingly, the Applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of claims 5-8 be withdrawn.

**Rejections of Claims 18-19 — 35 U.S.C. § 102(b)**

Currently amended independent claim 18 is:

A method for use with a bidding apparatus including a computer, a computer-based auction system, the auction system communicatively coupled with sellers and bidders, the system having records indicative of sellers of items and records indicative of bidders for the items and identifying for each item a winning bidder in an auction, the method comprising the steps of:

- by a[[the]] searcher, selecting a first item;
- by the computer, obtaining information indicative of identities of second bidders other than the first bidder who previously placed respective bids for the first item;
- by the computer, finding second items other than the first item for which bids have been placed by one or more of the second bidders;
- by the searcher, communicating the second items to a first bidder;
- by the first bidder, choosing a second item for which the auction has not yet ended and for which the first bidder has not yet placed a bid; and
- by the first bidder, placing a bid for the second item prior to the end of the auction, the bid higher than any bid previously placed for the second item.

The Examiner has cited paragraph [0010] in Montgomery as disclosing the second element of claim 18. However, the undersigned has diligently read the Examiner-cited passage and has failed to identify any wording that even hints at “the computer[] obtaining information indicative of identities of second bidders other than the first bidder who previously placed respective bids for the first item.” The undersigned even went further and performed various electronic word searches of both the Montgomery publication and of the associated and recently issued U.S. Patent No. 7,461,024, and still could not find the second element of claim 18 disclosed. There seems to be absolutely no disclosure in Montgomery related to the identification of competing “second bidders”.

Regarding the third element of claim 18, the undersigned has diligently read the

Examiner-cited passage of paragraph [0033] of Montgomery (as well as the associated Figure 2), and has failed to identify any wording that even hints at “the computer[.]finding second items other than the first item for which bids have been placed by one or more of the second bidders.” There is perhaps disclosure of a first bidder selecting multiple auctions for the same or several different items; however, that falls far short of reading on the third element of claim 18. The undersigned even went further and performed various electronic word searches of both the Montgomery publication and of the associated and recently issued U.S. Patent No. 7,461,024, and still could not find the third element of claim 18 disclosed.

The fifth element of claim 18 is also not disclosed by Montgomery. The Examiner cites the following passage from the Abstract of Montgomery to supposedly disclose the fourth element of claim 18: “

The method can enable activation of bid proxies as an auction nears completion to begin placing bids until the auction is won or lost by auction closing and can confirm a counter-offer has not out-bid. The method can compute and execute another higher bid if a counter-offer has been made and accepted, higher than the most recent bid detected.

The above passage seems to disclose the updating of a bidder’s bid for an item, but not the selection by a bidder of a second item to bid on, as called for in the fourth element of claim 18.

Because Montgomery does not disclose all of the limitations of independent claim 18, Montgomery cannot anticipate independent claim 18; thus, this claim rejection should be withdrawn. In turn, because dependent claim 19 incorporates all of the limitations of independent claim 18, it follows that Montgomery cannot anticipate dependent claim 19 either.

Accordingly, the Applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of claims 18-19 be withdrawn.

#### **Rejections of Claims 20-22 — 35 U.S.C. § 102(b)**

Independent claim 20 is:

A method for use with a bidding apparatus including a computer, a computer-based auction system, the auction system communicatively coupled with sellers and bidders, the system having records indicative of sellers of items and records indicative of bidders for the items and identifying for each item a winning bidder in an auction, the method comprising the steps of:

for a user, identifying instances of a bidder bidding on an item that the user has bid on;

if the number of such instances exceeds a predetermined threshold, adding that bidder to a list of bidders of interest.

Neither paragraph [0075] of Montgomery cited by the Examiner, nor its corresponding Figure 8, disclose the second element of claim 20. The undersigned diligently read the Examiner-cited passage and associated figure from Montgomery and cannot find any reference to adding a given bidder to a list of bidders of interest if the number of instances of identifying that given bidder of a given item that the user has bid on exceeds a predetermined threshold. The Examiner is respectfully requested to show/explain exactly where in Montgomery the second element of claim 20 is disclosed.

Because not all of the elements of independent claim 20 are recited by Montgomery, independent claim 20 cannot be anticipated by Montgomery; thus, this claim rejection should be withdrawn. In turn, because dependent claims 21-22 incorporate all of the limitations of independent claim 20, it follows that Montgomery cannot anticipate dependent claims 21-22 either.

Accordingly, the Applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of claims 20-22 be withdrawn.

#### **Rejections of Claims 23-25 — 35 U.S.C. § 102(b)**

Independent claim 23 is:

A method for use with a bidding apparatus including a computer, a computer-based auction system, the auction system communicatively coupled with sellers and bidders, the system having records indicative of sellers of items and records indicative of bidders for the items and identifying for each item a winning bidder in an auction, the method comprising the steps of:

for a user, identifying instances of a seller offering an item that the user has bid on;

if the number of such instances exceeds a predetermined threshold, adding that seller to a list of sellers of interest.

Regarding the first element of independent claim 23, paragraph [0010] of Montgomery cited by the Examiner disclose, or even hint at “identifying instances of a seller offering an item

that the user has bid on”. The undersigned diligently read the Examiner-cited passage and associated figure from Montgomery and cannot find any reference the subject matter in the first element of claim 23. The Examiner is respectfully requested to show/explain exactly where in Montgomery the first element of claim 23 is disclosed.

Regarding the second element of independent claim 23, paragraph [0017] of Montgomery cited by the Examiner disclose, or even hint at adding a given seller to a list of sellers of interest, if the number of instances of that given seller being identified as offering an item the user has bid on exceeds a predetermined threshold. The undersigned diligently read the Examiner-cited passage and associated figure from Montgomery and cannot find any reference the subject matter in the second element of claim 23. The Examiner is respectfully requested to show/explain exactly where in Montgomery the second element of claim 23 is disclosed.

Because none of the elements of independent claim 23 are recited by Montgomery, independent claim 23 cannot be anticipated by Montgomery; thus, this claim rejection should be withdrawn. In turn, because dependent claims 24-25 incorporate all of the limitations of independent claim 23, it follows that Montgomery cannot anticipate dependent claims 24-25 either.

Accordingly, the Applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of claims 23-25 be withdrawn.

### ***Claim Rejections — 35 U.S.C. § 103***

The Examiner has rejected claims 1-4 and 9-13 under 35 U.S.C. § 103. However, as discussed *supra*, these claims were canceled in a Preliminary Amendment. Since these claims are not pending, the Examiner’s 35 U.S.C. § 103 rejections are moot.

### ***Conclusion***

For all of the reasons stated herein, the Applicant has presented arguments and facts that refute all of the Examiner’s claim rejections. Therefore, the Applicant respectfully requests that all claim rejections be withdrawn and that a Notice of Allowance be issued.

Respectfully submitted,

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/s/  
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